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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,611	04/03/2001	Sujit Sharan	95-0716.02	3508

7590 12/31/2003

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EXAMINER

KILDAY, LISA A

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,611

Applicant(s)

SHARAN ET AL.

Examiner

Lisa A Kilday

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 35,36 and 40-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 37-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Election/Restrictions

The requirement is still deemed proper and is therefore made FINAL.

The response filed on 10/6/03 electing all claims pursuant to the restriction and presenting claims drawn to multiple inventions is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because they contain elements from different species.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Despite the nonresponsive status of the application, the examiner will address applicant's traversal of the restriction requirement to expedite prosecution.

Applicant's election with traverse of an atmosphere on 10/6/03 is acknowledged. The traversal is on the ground(s) that the species restriction is a burden to the applicant. Applicant's representative argues that the species restriction is "unduly cost prohibitive", would result in "inefficient prosecution for the PTO" and "an abuse of discretion." The examiner will not address these comments because they are unrelated to the merits of the case. For further guidance, the applicant's representative is reminded of §1.3 of the Patent Rules of the MPEP which states that applicants and their attorneys or agents are required to conduct their business with the PTO with decorum and courtesy.

Applicant argues that because of this restriction the applicant will have to file multiple costly separate continuation or division-like application filings to completely prosecute specific claims directed to each of the stated species. Applicant's point is not persuasive. A restriction is proper when one of two or more claimed inventions can support separate patents. See MPEP 806.04(f). Each patent can only be for one invention. See MPEP 806.04(h). Furthermore, the applicant pointed out that the instant specification contained 84 *patentably distinct* species. Therefore, there is a serious burden on the examiner. See MPEP 803; 37 CFR 1.142.

Applicant argues that the species restriction is not based on the claims. This point is not persuasive for several reasons. The species restrictions are based on the specification. Species restrictions give weight to the claims and drawings, which are part of the specification. Species restrictions do not have to follow the claims; it is preferred that species restrictions look at the entire specification. A species restriction is done to prevent future prosecution that includes claims previously presented in past applications, e.g. prevent double patenting. See MPEP 804. A species restriction is done to narrow each application to a single invention. An applicant is not precluded from presenting claims in an RCE or CIP that are drawn to non-elected inventions. But, an applicant cannot present claims that were already prosecuted. Upon allowance of an independent claim, some species may be rejoined with the original elected claims.

Conclusion

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0957. See MPEP 203.08.

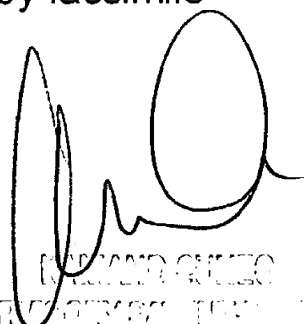
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Any inquiry concerning this communication from the examiner should be directed to Lisa Kilday whose telephone number is (703) 306-5728. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo, can be reached on (703) 308-1233. My new telephone number after 1/13/04 will be: (571) 272-1962. My supervisor, Kamand Cuneo, can be reached at (571) 272-1957 after 1/13/04. The fax number for the group is (703) 305-3432. MPEP 502.01 contains instructions regarding procedures used in submitting responses by facsimile transmission.

Lisa Kilday

LAK

12/23/03



KAMAND CUNEO
SUPERVISOR, IP/TECHNICAL
TECHNICAL GROUP